

REMARKS / DISCUSSION OF ISSUES

Claims 5, 7, 9-10, and 12-25 are pending in the application.

The Office action rejects claims 5, 7, 9-10, 12-21, and 24-25 under 35 U.S.C. 102(e) over Venkatraman et al. (USP 6,139,177, hereinafter Venkatraman). The applicant respectfully traverses this rejection.

Claim 5, upon which claims 18-20 depend claims an appliance that includes a controller and a receiver that receives a device identifier corresponding to a relay server from a remote communications device; the controller being programmed to transmit data corresponding to the device identifier to the relay server, receive a profile address of a profile server in response from the relay server, and receive profile data from the profile server.

The Office action fails to identify where Venkatraman teaches an appliance that includes a controller and a receiver that receives a device identifier corresponding to a relay server from a remote communications device; the controller being programmed to transmit data corresponding to the device identifier to the relay server, receive a profile address of a profile server in response from the relay server, and receive profile data from the profile server.

MPEP 2131 states:

"A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The **identical invention** must be shown in as **complete detail** as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Board of Patent Appeals and Interferences has consistently upheld the principle that the burden of establishing a *prima facie* case resides with the Office, and to meet this burden, the Examiner must specifically identify where each of the claimed elements are found in the prior art:

"there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). To meet [the] burden of establishing a *prima facie* case of anticipation, the examiner must explain how the rejected claims are anticipated by pointing out where *all* of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

The applicant respectfully notes that it is the duty of the Examiner to specifically identify each and every element and limitation of a claim in the cited reference as per §1.104(c)(2) of Title 37 of the Code of Federal Regulations and section 707 of the M.P.E.P., which explicitly state that "the particular part relied on must be designated."

The Office action fails to identify where Venkatraman teaches an appliance that receives a device identifier from a remote communication device. The Office action asserts that a user's web browser corresponds to the claimed remote communication device, but provides no basis for this assertion, and, assuming in argument that Venkatraman's web browser corresponds to the claimed remote communication device, the Office action does not identify where Venkatraman teaches an appliance that receives a device identifier from Venkatraman's web browser.

Because the Office action fails to identify where Venkatraman teaches each of the elements of claim 5, the applicant respectfully maintains that the rejection of claims 5 and 18-20 under 35 U.S.C. 102(e) over Vank is unfounded, per MPEP 2131, and should be withdrawn.

Claim 9, upon which claims 10, 12-13, and 21-25 depend, claims a method of controlling the operation of an appliance that includes, among other elements, receiving, at the appliance, first access data from memory of a first remote device.

As noted above, the Office action fails to show where Venkatraman teaches an appliance that receives data from a remote device. Accordingly, the applicant respectfully maintains that the rejection of claims 9-10, 12-13, 21, and 24-25 under 35 U.S.C. 102(e) over Vank is unfounded, per MPEP 2131, and should be withdrawn.

Claim 14, upon which claims 15-17 depend, claims a method that includes receiving an address of a relay server from a remote device, transmitting a first request to the relay server, receiving an address of a profile server from the relay server, transmitting a second request to the profile server, receiving a profile from the profile server, and controlling the appliance in dependence upon the profile.

The Office action fails to identify where Venkatraman teaches receiving an address of a relay server from a remote device, transmitting a first request to the relay server, receiving an address of a profile server from the relay server, transmitting a second request to the profile server, receiving a profile from the profile server, and controlling the appliance in dependence upon the profile.

As in prior Office actions in this application, the asserted correspondence between the elements of the prior art and the elements of the applicant's claimed invention is inconsistent.

The Office action asserts that the "device homepage" of Venkatraman corresponds to the claimed "relay server", then subsequently asserts that the "device's web server" of Venkatraman corresponds to the claimed "relay server". Due to this inconsistency, the goal of prosecution has not been met under MPEP 706 because the Office has not clearly articulated its rejection so that the applicant could have the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.

In an attempt to advance prosecution in this case, the applicant herein addresses each of the inconsistent assertions.

If Venkatraman's "device homepage" is assumed to correspond to the claimed "relay server", the applicant notes that a first request is not sent to the device's homepage. As acknowledged in the Office action, Venkatraman teaches that a request is sent to the device's web server to download the device homepage; Venkatraman does not teach sending a request to this downloaded device homepage.

If Venkatraman's "device's web server" is assumed to correspond to the claimed "relay server", the applicant notes that an address of this web server is not received from a remote device (asserted in the Office action to be the user's web browser). As acknowledged in the Office action, Venkatraman teaches that the address of the device's homepage is communicated from the user's web browser; Venkatraman does not teach that the address of the user's web server is communicated from the user's web browser.

Because the Office action fails to identify where Venkatraman teaches each of the elements of claim 14, the applicant respectfully maintains that the rejection of claims 14-17 under 35 U.S.C. 102(e) over Venkatraman is unfounded, per MPEP 2131, and should be withdrawn.

The Office action rejects claims 22 and 23 under 35 U.S.C. 103(a) over Venkatraman and Hanko et al. (USP 6,912,578, hereinafter Hanko). The applicant respectfully traverses this rejection.

MPEP 2142 states:

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) **must teach or suggest all the claim limitations**... If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

In this rejection, the Office action relies upon Venkatraman for teaching the elements of claim 9, upon which claims 22-23 depend. As noted above, Venkatraman fails to teach the elements of claim 9, and thus the applicant respectfully maintains that the rejection of claims 22 and 23 under 35 U.S.C. 103(a) that relies upon Venkatraman for this teaching is unfounded, per MPEP 2142, and should be withdrawn.

In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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